

UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 05-434-B)

In re Application of:

Woo Seog KOO

International Application No.: PCT/KR2004/01856

U.S. Application No.: 10/560,142

International Filing Date: July 23, 2004

U.S. Filing Date: December 9, 2005

For: Method For Establishing an ATM Traffic
Channel Path Between a BSC and a BTS

Mail Stop PCT

Commissioner for Patents

Office of PCT Legal Administration

P.O. Box 1450

Alexandria, VA 22313-1450

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) Examiner: TBA

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) Group Art Unit: 2616

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) Confirmation No. 1170

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Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Sir/Madam:

In regard to the above identified application.

1. We are transmitting herewith the attached:
 - a) Renewed Petition Under 37 C.F.R. 1.47(b);
 - b) Joo-Young Kim's Declaration In Support Of Petition Under 37 C.F.R. § 1.47(B) By Person Having Proprietary Interest To File Application On Behalf Of Inventor;
 - c) Memorandum Of Law In Support Of Petition Under 37 C.F.R. § 1.47(B) By Person Having Proprietary Interest To File Application On Behalf Of Inventor with Exhibits 1-2;
 - d) Schedule A; and
 - e) Return Receipt Postcard.
2. With respect to fees:
 - a) No fees are due at this time.
 - b) Please charge any underpayment or credit any overpayment to our Deposit Account No. 13-2490.
3. CERTIFICATE OF MAILING UNDER 37 CFR § 1.10: The undersigned hereby certifies that this Transmittal Letter and the papers, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service with sufficient postage as "Express Mail Post Office to Addressee," addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450 on January 17, 2007 under Express Mail Certificate No. EV839329576US.

Respectfully submitted,


Robert J. Irvine III
Registration No. 41,865

Date: January 17, 2007

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 05-434-B)

In re Application of:)
Woo Seog KOO)
International Application No.: PCT/KR2004/01856) Examiner: TBA
U.S. Application No.: 10/560,142) Group Art Unit: 2616
International Filing Date: July 23, 2004)
U.S. Filing Date: December 9, 2005) Confirmation No. 1170
For: Method For Establishing an ATM Traffic)
Channel Path Between a BSC and a BTS)
In an EV-DO System)

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P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
23 JAN 2007
Legal Staff
International Division

RENEWED PETITION UNDER 37 C.F.R. 1.47(b)

Dear Sir:

Reconsideration of the November 17, 2006 Decision on Petition Under 37 C.F.R. 1.47(b) by a Person Having Proprietary Interest to File an Application on Behalf of a Non-Signing Inventor, filed November 2, 2006, is respectfully requested.

The petition was dismissed without prejudice because Applicant's proof under 37 CFR 147(b) that it has sufficient proprietary interest in the application was allegedly inadequate.

The Applicant encloses the following documents to address the alleged deficiency of proof in showing that UTStarcom has sufficient proprietary interest in the application:

- 1) Joo-Young Kim's DECLARATION IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(b) BY PERSON HAVING PROPRIETARY INTEREST TO FILE APPLICATION ON BEHALF OF INVENTOR
- 2) MEMORANDUM OF LAW IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(b) BY PERSON HAVING PROPRIETARY INTEREST TO FILE APPLICATION ON BEHALF OF INVENTOR
- 3) SCHEDULE A

The Applicant believes that these documents sufficiently demonstrate that UTStarcom has proprietary interest in the above-referenced application, in accordance with MPEP §409.03(f).

The Applicants respectfully request that this Renewed Petition Under 37 CFR 1.47(b) be granted. If it would be deemed helpful, the PCT Attorney Advisor is encouraged to contact the undersigning attorney.

Respectfully submitted,

Date: January 17, 2007


Robert J. Irvine, III
Reg. No. 41,865
McDonnell Boehnen Hulbert & Berghoff LLP
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Chicago, IL 60606
Tel: 312 913 - 0001
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DECLARATION IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(b) BY
PERSON HAVING PROPRIETARY INTEREST TO FILE APPLICATION ON BEHALF
OF INVENTOR

Dear Sir:

This Declaration is in support of Petition under 37 C.F.R. § 1.47(b) to allow UTStarcom, Inc. to make the application on behalf of the non-signing inventor(s) listed in Schedule A, column 3, whom we have been unable to locate.

1. I, Joo-Young Kim, am a citizen of Korea, residing at Sangyong, Apt No. 103-1101, Sungsu-dong 1-ga 16/3, Sungdong-gu, Seoul, Republic of Korea.

2. I am a Korean patent attorney with the law firm of Kim & Chang, located at Hungkuk Life Insurance Building, 9F, 226 Sinmunno 1-ga, Jongno-gu, Seoul 110-786, Korea.

3. On behalf of Kim & Chang, I am representing UTStarcom Korea Limited, a wholly owned subsidiary of UTStarcom, Inc.

4. I am knowledgeable regarding Korean Patent Law.

5. I submit this declaration in support of the accompanying memorandum of law.

6. The Korean company Hyundai Syscomm filed the Korean National Application listed in Schedule A, Column 6 as the applicant of record, with inventor(s) in Schedule A, column 3 listed as the inventor(s).

7. The filing of the above-referenced Korean Application by Hyundai Syscomm was not opposed by the Examiner or any third party including the employee/inventor.

8. On April 27, 2004, UTStarcom, Inc., through its wholly owned subsidiary UTStarcom Korea Limited, acquired Hyundai Syscomm's Intellectual Property Portfolio, including the rights to the Korean National Application listed in Schedule A, column 6, and duly recorded this change of ownership with the Korean Intellectual Property Office without objection.

9. As a result of the acquisition, UTStarcom, Inc. became the sole proprietary owner of Hyundai Syscomm's Intellectual Property Portfolio, which includes the above-referenced Korean National Application.

10. UTStarcom Korea Limited filed the PCT application listed in Schedule A, column 8, claiming priority to the above-referenced Korean National Application.

11. The above-referenced PCT application entered U.S. National phase in the United States on the date listed in Schedule A, column 5, having the U.S. Application Serial Number listed in Schedule A, column 4.

12. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date: 16-January-2007

By:



Joo-Young Kim
Kim & Chang
Hungkuk Life Insurance Building,

9F,

226 Sinmunno 1-ga, Jongno-gu,
Seoul 110-786, Korea

MEMORANDUM OF LAW IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(b) BY PERSON HAVING PROPRIETARY INTEREST TO FILE APPLICATION ON BEHALF OF INVENTOR

This memorandum of law is in support of Petition under 37 C.F.R. § 1.47(b) to allow UTStarcom, Inc. ("UTStarcom") to make the application on behalf of a non-signing inventor.

BACKGROUND

UTStarcom submitted a Petition under 37 C.F.R. § 1.47(b) to allow UTStarcom to make the Application, listed in Schedule A, column 4, on behalf of the inventor listed in Schedule A, column 3, whom UTStarcom has been unable to locate. The Petition was denied on the grounds that UTStarcom allegedly failed to establish a proprietary interest in the above-referenced U.S. Application.

STATEMENT OF FACTS

All facts in support of the argument and conclusion are set forth in the Declaration of Andrew Choung under M.P.E.P. 409.03(f).

ARGUMENT AND CONCLUSION

UTStarcom should be awarded title to the above-referenced U.S. Application because UTStarcom, as the assignee of patent rights to the underlying Korean Application and subsequent patent applications granted by the assignor Hyundai Syscomm Inc. ("Hyundai Syscomm"), is the sole proprietary owner of the U.S. Application.

Under Korean Patent Law, UTStarcom is recognized as the owner of the Korean Application. First, the Korean Intellectual Property Office recognizes UTStarcom as the current owner of the Korean Application as a matter of record. Second, the invention disclosure form executed by the inventor in favor of Hyundai Syscomm, which includes an assignment of the subject matter of the Korean Application from the inventor to Hyundai Syscomm, is more than sufficient to overcome any challenge to UTStarcom's ownership interest.

The Korean Patent Act provides that a patent application of an employee may be filed directly by the employee's company, without an explicit assignment from the employee to the employee's company. Korean Patent Act, Article 42 (See Attached Exhibit 1). Unless the examiner or a third party contests the company's right to file the application, the company becomes the owner of the application. Thus, even in the absence of an employee-inventor assignment, a Korean Patent Application filed by a company without contest by others is the proprietary owner of the patent rights. See Korean Patent Act, Article 42, Para 1 (See Attached Exhibit 1).

In the instant case, Hyundai Syscomm filed the Korean National Application listed in Schedule A, column 6, as the named applicant. The filing of the application was not contested by the Examiner or any third party. Thus, under Korean Law, Hyundai Syscomm became the owner of the Korean application even in the absence of an employee inventor assignment. Subsequently, the Hyundai Syscomm's patent portfolio, including the above-mentioned Korean Application, was assigned to UTStarcom. This assignment was recorded with the Korean Intellectual Property Office, without objection, making UTStarcom the legal owner of the above-mentioned Korean Application.

Under the present circumstances, only the inventor(s) may challenge the legitimacy of Hyundai Syscomm's ownership of the Korean Application. Korean Patent Act, Articles 34 and 35 (See Attached Exhibit 1). However, any challenge by the inventor(s) would fail under Korean Patent Law. The inventor(s) executed an invention disclosure form, which assigns the subject matter of the Korean Application to Hyundai Syscomm. Because the subject matter described in the invention disclosure form is virtually identical to the subject matter contained in the Korean Application, the assignment therein would be deemed by a Korean court of law to assign the Korean Application to Hyundai Syscomm. See In-Chul Choi v. Samsung Electronics Co., Ltd., 2001 Gahap 13977 (Seoul District Court, August 22, 2002) (See Attached Exhibit 2) (recognizing the validity of the assignment based on the content in the invention disclosure form despite the absence of a specific application number reference). Thus, even if challenged, the chain of title of the Korean Application would be sustained under Korean Patent Law and UTStarcom would remain the ultimate owner.

This ownership of the Korean Application, in conjunction with the other assignment terms of the acquisition agreement previously submitted, establishes UTStarcom's rights to the subsequent PCT application and U.S. national phase application. Thus, UTStarcom has a proprietary interest in the referenced U.S. Application listed in Schedule A, column 3, and should be allowed to make the application in U.S. on behalf of the missing inventor under 37 C.F.R. § 1.47(b).

Respectfully submitted

Date: 16-January-2009 By: 

Joo-Young Kim

9F,

Kim & Chang
Hungkuk Life Insurance Building,

226 Sinmunno 1-ga, Jongno-gu,
Seoul 110-786, Korea

Exhibit 1

[KOREAN PATENT ACT]

제 34 조 (무권리자의 특허출원과 정당한 권리자의 보호)

발명자가 아닌 자로서 특허를 받을 수 있는 권리의 승계인이 아닌 자(이하 "무권리자"라 한다)가 한 특허출원이 제 33 조제 1 항 본문의 규정에 의한 특허를 받을 수 있는 권리를 가지지 아니한 사유로 제 62 조 제 2 호에 해당되어 특허를 받지 못하게 된 경우에는 그 무권리자의 특허출원후에 한 정당한 권리자의 특허출원은 무권리자가 특허출원한 때에 특허출원한 것으로 본다. 다만, 무권리자가 특허를 받지 못하게 된 날부터 30 일을 경과한 후에 출원을 한 경우에는 그러하지 아니하다.

제 35 조 (무권리자의 특허와 정당한 권리자의 보호)

제 33 조제 1 항 본문의 규정에 의한 특허를 받을 수 있는 권리를 가지지 아니한 사유로 제 69 조 제 1 항 제 2 호에 해당되어 특허취소결정이 확정된 경우 또는 제 33 조 제 1 항 본문의 규정에 의한 특허를 받을 수 있는 권리를 가지지 아니한 사유로 제 133 조 제 1 항 제 2 호에 해당되어 특허를 무효로 한다는 심결이 확정된 경우에는 그 특허출원후에 한 정당한 권리자의 특허출원은 취소 또는 무효로 된 그 특허의 출원시에 특허출원한 것으로 본다. 다만, 그 특허의 등록공고가 있는 날부터 2년을 경과한 후에 특허출원을 하거나 취소결정 또는 심결이 확정된 날부터 30 일을 경과한 후에 특허출원을 한 경우에는 그러하지 아니하다.

[TRANSLATION]

Article 34 (Patent Application Filed by an Unentitled Person and Protection of the Lawful Holder of a Right)

Where a patent cannot be granted because an application was filed by a person who is not the inventor or a successor to the right to obtain a patent (referred to as "an unentitled person") under Article 33(1) as prescribed in Article 62(ii), a subsequent application filed by the lawful holder of the right is deemed to have been filed on the filing date of the earlier application filed by the unentitled person. This provision does not apply, however, if the subsequent application is filed by the lawful holder of the right more than thirty days after the date on which the application filed by the unentitled person was rejected.

Article 35 (Patent Granted to an Unentitled Person and Protection of the Lawful Holder of a Right)

Where a decision to revoke a patent becomes final for lack of entitlement to obtain a patent under Article 33(1) as prescribed in Article 69(1)(ii) or a decision to invalidate becomes final due to a lack of entitlement under Article 33(1) as prescribed in Article 133(1)(ii), a subsequent application filed by the lawful holder of the right is deemed to have been filed on the filing date of the revoked or invalidated application. However, this provision does not apply if the subsequent application is filed more than two years after the publication date of the first application or more than thirty days after the decision to revoke or invalidate becomes final.

[KOREAN PATENT ACT]**[TRANSLATION]****제 42 조 (특허출원)**

①특허를 받고자 하는 자는 다음 각호의 사항을 기재한 특허출원서를 특허청장에게 제출하여야 한다.

1. 특허출원인의 성명 및 주소(법인인 경우에는 그 명칭 및 영업소의 소재지)
2. 특허출원인의 대리인이 있는 경우에는 그 대리인의 성명 및 주소나 영업소의 소재지(대리인이 특허법인인 경우에는 그 명칭, 사무소의 소재지 및 지정된 변리사의 성명)
3. 삭제
4. 발명의 명칭
5. 발명자의 성명 및 주소
6. 삭제

Article 42 (Patent Application)

(1) A person seeking to register a patent shall file a patent application with the Commissioner of the Korean Intellectual Property Office, stating the following:

- (i) the name and address of the applicant (and, if a legal entity, the name and address of the business);
- (ii) the name and residential or business address of the agent, if any (and, if the agent is a patent legal entity, the name and address of the business and the name of the designated patent attorney);
- (iii) deleted;
- (iv) the title of the invention;
- (v) the name and address of the inventor;
- (vi) deleted.

Exhibit 2

Seoul Southern District Court

Judgment

Case No. 2001 Gahap 13977
Plaintiff: In Chul Choi
Defendant: Samsung Electronics Ltd.
Pronouncement: August 22, 2002

ORDER

The confirmation claim of the present action is dismissed.

Tenor of Complaint

Plaintiff hereby seeks confirmation that the patented inventions, described in the patent right list of the accompanying sheet, do not belong to an in-service invention.

GROUNDS

1. Findings of Facts

A. The Defendant's company, taking fabrication, sale, etc. of communication mechanisms and related devices as its objective under its constitution, has manufactured mobile-phone terminals since May of 1989.

The Plaintiff entered the Defendant's company on January 10, 1989, and had served as a member of a team known as the "Time Machine Team (TMT)" between July 13, 1992 and February 16, 1995.

B. TMT of the Defendant's company is a department that was organized by selecting incumbent staff to create ideas for new product development. TMT holds a weekly evaluation meeting, where team members exchange ideas equipped with marketability and practicability, and hold quarterly meetings that report the results to the board of directors, assigning no specific tasks to its team members. The Plaintiff was mainly focused on conceiving and commercializing a new Hangul inputting method, submitting a report titled "Value of Text in the Multimedia World" showing the needs and practicability

of a new Hangul inputting method on May 20, 1994, and a report titled "First report regarding commercialization drive of a new Hangul inputting method" on July 18, 1994, together with his teammate, Dong Ki Rui.

C. During his tenure on TMT, the Plaintiff invented "Method and Apparatus for Generating Text Inputting Codes (hereinafter, referred to as the 'first invention')," described in patent right list 1 of the accompanying sheet, and transferred the right to obtain a patent for the Defendant's company while providing an in-service invention report on the first invention on February 19, 1993. The Defendant's company filed a patent application for the first invention in its name on July 6, 1993, and completed the patent registration on March 13, 1996.

D. Furthermore, the Plaintiff, together with his teammate, Dong Ki Rui, invented "Method and Apparatus for Generating Text Inputting Codes (hereinafter, referred to as the 'second invention'))" described in patent right list 2, and transferred the right to obtain a patent for the Defendant's company while providing an in-service invention report on the second invention on October 13, 1994. The Defendant's company filed a patent application for the second invention in its name on May 11, 1995, and completed the patent registration on August 10, 1998.

E. The Defendant's company has manufactured and sold mobile-phone terminals using the text inputting methods of the inventions since November of 1998.

2. The Plaintiff's Claims and Holding thereon

A. Gist of the Plaintiff's Claims

The Plaintiff seeks: (a) confirmation that the fist and second inventions are not an in-service invention, arguing that the inventions were misconceived as an in-service invention and filed in the name of the Defendant's company although they actually belong to a liberal invention; and (b) the Defendant's return of 1 billion KrW as part of an unjust enrichment, arguing that since the contracts of transfer were based on a misconception for

the inventions to be an in-service invention are invalid, the Defendant is not a legitimate patentee and has an obligation to return, to the Plaintiff, the profits earned by practicing the inventions as an unjust enrichment.

B. Relevancy of the Confirmation Claim

The Defendant made a defense prior to a main hearing that the Plaintiff's confirmation claim lacks eligibility and thus is irrelevant because it seeks confirmation of a factual matter. The Plaintiff seeks the confirmation for the first and second inventions to not be an in-service invention as a basis for the unjust enrichment return claim being sought by the present action. This is to confirm part of a legal requirement fact, and thus is irrelevant. Furthermore, the confirmation stake of a confirmation action can be recognized if the obtainment of a confirmation judgment is the most effective and appropriate means for eliminating the challenge and risk when the plaintiff's legal status is challenged and risked. However, as will be seen in item C. (1), even though the first and second inventions were not an in-service invention, this would not affect the patent right registered in the name of the Defendant's company, unless the invalidation decision is rendered and becomes final and conclusive in a patent registration invalidation trial. Therefore, because seeking the confirmation for the inventions to not be an in-service invention cannot be seen as an effective and appropriate means, the Plaintiff's confirmation claim of the present action is irrelevant.

C. Unjust Enrichment Return Claim

(1) The Plaintiff argues first, that since the first and second inventions are not an in-service invention but a liberal one, each contract for transferring each right to obtain a patent to the Defendant is invalid *per se* for primitive impossibility of the objective of a legal activity or under Article 39, Paragraph 1 of the Patent Act, or invalid for violating Article 103 of the Civil Code.

In regard to this, if the first and second inventions belong to a liberal invention, Article 39, Paragraph 1 of the Patent Act stipulates that an invention constitutes an in-service invention if the invention was made by an employee, etc. in connection with his/her service and falls by nature within the business

range of the employer, etc., and the activity resulting into the invention was part of the present or past duties of the employee, etc.

As previously seen, the Defendant's company takes the fabrication and sale of communication mechanisms as one of its founding objectives, and has set the mobile-phone terminal as one of the primary manufactured items from the year of 1989 through to the present time. Since the inventions are directed to a text inputting method usable for mobile-phone terminals, these are regarded to fall within the business range of the Defendant's company. Furthermore, the Plaintiff's then duty was to create ideas for new products development in the field of the information and telecommunication at the time of conceiving each invention, and the Plaintiff reached the first and second inventions substantially as a result of focusing mainly on collecting ideas for a Hangul inputting method. As such, each invention is determined to fall within the Plaintiff's duty.

Therefore, since the first and second inventions should belong to an in-service invention, the Plaintiff's arguments contend the validity of each transfer contact on premise of the opposite.

(2) The Plaintiff also argues that since the patent application for the second invention was filed four months after the Defendant's company succeeded to the right to the invention from the Plaintiff, the second invention should be regarded as a liberal invention under Article 11, Paragraph 1 of the Invention Promotion Act, and the Defendant should return unjust enrichment, amounting to the royalty of a non-exclusive license, for failing to obtain consent to a non-exclusive license from the inventor Plaintiff under Article 2 of the same.

Article 11 of the Invention Promotion Act views an invention as a liberal invention in case an employer, etc. fails to file a patent application within a period designated under the Presidential Order (Article 5 of the same designates the period for four months) after succeeding the right to an in-service invention or waive filing of the application in writing (Paragraph 1), and stipulates that the employer, etc. cannot own a non-exclusive license to the in-service invention being regarded as a liberal one without the consent of the employee, etc in spite of Article 39, Paragraph 1 of the Patent Act (Paragraph

2). The fact that the Defendant's company filed the application for the second invention on May 11, 1995, four months passing from October 13, 1994 when the Defendant's company succeeded to the right to the second invention from the Plaintiff, is as previously seen.

However, even if the Defendant's company had completed the patent registration in its name, although the transfer contract of the second invention was invalidated under the above provision and the Defendant's company did not have a right to obtain a patent, the Plaintiff could not assert invalidity of the patent right having been registered in the name of the Defendant's company until the patent invalidation decision goes final and conclusive. Of course, the Plaintiff could request a patent invalidation trial based on the above grounds, which however, is not feasible here. Therefore, the Defendant has a right to legally practice the invention, and needs not obtain consent of the Plaintiff for practicing the invention because the Plaintiff did not register the patent in his/her own name. As such, the Plaintiff's above arguments are groundless and unreasonable.

서 울 지 방 법 원
남 부 지 원
판 결

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원 고 최인철
피 고 삼성전자주식회사
판 결 선 고 2002. 8. 22.

주 문

이 사건 소 중 확인청구 부분을 각하한다.

청 구 취 지

원고와 피고 사이에서 별지 특허권목록 기재 1, 2의 특허발명은 직무발명이 아님을 확인한다.

이 유

1. 기초사실

가. 피고회사는 통신기계기구 및 관련기구와 그 부품의 제작, 판매 등을 그 정관상의 목적으로 하고, 1989. 5. 경부터 이동전화단말기를 생산해 온 회사이고, 원고는 1989. 1. 10. 피고회사에 입사하여 1992. 7. 13.부터 1995. 2. 16.까지 사이에 피고회사의 '타임머신팀'에 소속되어 근무하였다.

나. 피고회사의 '타임머신팀'은 신상품개발을 위한 아이디어 창출을 위하여 사내공모를 통해 직원을 선발, 조직한 부서로 그 팀원들은 구체적인 특정 업무를 맡지 아니한 채 매주 팀원들간에 시장성과 실현성 있는 아이디어를 제출하는 평가회를 가지고, 분기별로 경영진을 대상으로 그 결과물을 발표하는 정기 보고회를 개최하였는데, 원고는 같은 팀원인 류동기와 함께 1994. 5. 20. 새로운 한글입력방식의 필요성과 실용화 방안에 관한 '멀티미디어 세계에서 문자의 가치'라는 보고서를, 1994. 7. 18. '새로운 한글입력방법 사업화추진 1차 보고서'를 각 제출하는 등 주로 새로운 한글입력방식의 고안 및 사업화에 주력하였다.

다. 원고는 위 타임머신팀에 근무하던 중, 별지 특허권목록 1. 기재의 '문자입력코드 발생방법 및 장치'(이하 '제1발명'이라 한다)를 발명하고, 1993. 2. 19. 피고회사에 제1발명에 관한 직무발명신고를 하면서 특허받을 권리를 양도하였으며, 피고회사는 1993. 7. 6. 피고회사 명의로 제1발명에 관한 특허를 출원하여 1996. 3. 13. 특허등록을 마쳤다.

라. 또한 원고는 위 류동기와 함께 위 목록 2. 기재의 '문자입력코드 발생장치 및 방법'(이하 '제2발명'이라 한다)을 발명하고, 1994. 10. 13. 피고회사에 제2발명에 관한 직무발명신고를 하면서 특허받을 권리를 양도하였으며, 피고회사는 1995. 5. 11. 피고회사 명의로 제2발명에 관한 특허를 출원하여 1998. 8. 10. 특허등록을 마쳤다.

마. 피고회사는 1998. 11.경부터 위 발명들의 문자입력방식을 이용한 이동전화단말기를 생산, 판매해 오고 있다.

2. 원고의 청구 및 이에 대한 판단

가. 원고의 청구내용

원고는 ① 위 각 발명은 원고 개인의 자유발명에 해당됨에도 직무발명으로 오인되어 피고 명의로 특허등록이 된 것이라고 주장하면서 제1, 2발명이 직무발명이 아니라는 확인을 구하고, ② 위 발명들을 직무발명으로 오인하고 체결한 각 양도계약이 무효인 이상 정당한 특허권자가 아닌 피고는 위 발명들을 실시하여 얻은 수익을 부당 이득으로서 원고에게 반환할 의무가 있다고 주장하면서, 그 일부로서 10억원을 지급할 것을 구한다.

나. 확인청구 부분의 적법성

피고는, 원고의 위 확인청구는 사실관계의 확인을 구하는 것으로 확인의 소의 대상적격이 없어 부적법하다고 본 안전 항변을 하므로 살피건대, 원고의 위 확인청구는 원고가 이 사건 소로써 구하고 있는 부당이득반환청구의 전제로 제1, 2발명이 직무 발명이 아니라는 확인을 구하는 취지인바, 이는 법률요건사실 일부의 확인을 구하는 것이어서 부적법하고, 또한 확인의 소에 있어서 확인의 이익은 원고의 법적 지위가 불안, 위험할 때 그 불안, 위험을 제거하는데 있어 확인판결을 받는 것이 가장 유효·적절한 수단인 경우에 인정된다 할 것인데, 아래 다.의 (2)항에서 보는 바와 같이 가사 제1, 2발명이 직무발명이 아니라 하더라도 특허무효심판절차에서 무효심결이 확정되지 아니하는 이상에는 피고회사 명의로 등록된 특허권에 어떠한 효력이 미친다고 볼 수도 없으므로, 위 발명들이 직무발명이 아니라는 확인을 구하는 것은 원고에게 혼란하는 법적 불안, 위험을 해소할 수 있는 유효·적절한 수단이라 할 수 없으니, 결국 원고의 이 사건 소 중 확인청구 부분은 부적법하다.

다. 부당이득반환청구 부분

(1) 원고는 먼저, 제1, 2발명은 직무발명이 아닌 자유발명이므로 그 특허받을 권리 를 피고에게 양도한 위 각 양도계약은 법률행위 목적의 원시적 불능 또는 특허법 제39조 제3항에 의하여 당연 무효이거나 민법 제103조에 위반되어 무효라고 주장한다. 그러므로 과연 제1, 2발명이 자유발명인지에 관하여 보건대, 특허법 제39조 제1항은 직무발명의 개념에 관하여 종업원 등이 그 직무에 관하여 발명한 것이 성질상 사용자 등의 업무범위에 속하고, 그 발명을 하게 된 행위가 종업원 등의 현재 또는 과거의 직무에 속하는 경우 그 발명은 직무발명이라고 규정하고 있다.

앞에서 본 바와 같이 피고회사는 통신기계기구의 제작, 판매를 그 설립목적의 하나로 규정하고 있고, 1989년부터 현재까지 이동전화단말기를 주요 생산품목으로 하고 있으며, 위 발명들은 이동전화단말기에 이용될 수 있는 문자입력방식에 관한 발명이므로 피고회사의 업무범위에 속한다 할 것이다. 또한 위 각 발명 당시 원고의 직무는 정보통신부분의 신상품 개발을 위한 아이디어를 창출하는 것으로 실제 한글입력방식에 관한 아이디어 계발에 주력한 결과 제1, 2발명에 이르게 되었으므로 위 각 발명 행위는 원고의 직무에 속한다 할 것이다.

따라서 제1, 2발명은 직무발명에 해당한다고 보아야 할 것이므로, 위 발명들이 직무발명이 아님을 전제로 각 양도계약의 효력을 다투는 원고의 주장은 더 나아가 살펴 것 없이 이유 없다.

(2) 원고는 또한, 제2발명에서는 피고회사가 원고로부터 발명에 관한 권리를 승계한 때로부터 4개월이 지나서 특허를 출원하였으므로 이는 발명진흥법 제11조 제1항에 의하여 자유발명으로 간주되고, 같은 조 제2항에 따라 발명자인 원고로부터 통상실시에 대한 동의를 받지 아니한 이상 피고는 원고에게 통상실시로 상당의 부당이득을 반환하여야 한다고 주장한다.

살피건대, 발명진흥법 제11조는 사용자 등이 직무발명에 관한 권리를 승계한 후 대통령령이 정하는 기간(같은 법 시행령 제5조는 그 기간을 4개월로 정하고 있다)내에 출원을 하지 아니하는 경우 또는 서면으로 그 출원을 포기한 경우 당해 발명은 자유발명으로 보고(제1항), 자유발명으로 보는 직무발명에 대하여는 특허법 제39조 제1항의 규정에도 불구하고 당해 발명을 한 종업원 등의 동의를 받지 아니하고는 통상실

시권을 가질 수 없다(제2항)고 규정하고 있고, 피고회사가 원고로부터 제2발명에 관한 권리를 승계한 1994. 10. 13.로부터 4개월이 경과한 1995. 5. 11.에야 위 발명에 관한 특허를 출원한 사실은 앞에서 본 바와 같다.

그러나 가사 위 법률규정에 의하여 제2발명에 관한 양도계약이 무효가 되어 피고회사가 특허를 받을 권리를 가지지 아니함에도 불구하고 그 명의로 특허등록을 마쳤다 하더라도 원고가 그와 같은 사유를 들어 특허무효심판을 청구함은 별론으로 하고 특허무효심결이 확정되기 전에는 피고 명의로 등록된 특허권의 무효를 주장할 수는 없는 것이므로 피고는 특허권자로서 적법하게 그 발명을 실시할 권리가 있고, 또한 원고가 자기 명의로 특허등록을 받지 아니한 이상 피고회사가 위 발명을 실시함에 있어 원고의 동의를 얻어야 한다고 볼 수도 없으므로, 원고의 위 주장은 이유 없다.

SCHEDULE A

1 MBHB Reference No.	2 Title	3 Inventor(s)	4 U.S. Application No.	5 U.S. Filing Date	6 Korean Application No.	7 Filing Date (Korean Application)	8 PCT Application No.	9 Filing Date PCT National Phase
1 05-386-B	Method For Stabilizing BTS Using E1 Trunk Board Duplexing Of BSC	Se Yeon KIM	10/545,922	August 17, 2005	2003-0018549	March 25, 2003	PCT/KR2004/00645	March 24, 2004
2 05-390-B	Method For Optimizing A DSP Input Clock Using A Comparing/Analyzing Circuit	Seong Chul SHIN	10/545,505	August 12, 2005	2003-0018553	March 25, 2003	PCT/KR2004/00655	March 24, 2004
3 05-392-B	Method For Trunk Line Duplexing Protection Using A Hardware Watchdog	Yeong Weon JUNG	10/545,895	August 17, 2005	2003-0018554	March 25, 2003	PCT/KR2004/00654	March 24, 2004
4 05-428-B	Device for Implementing a RNC Using LVDS	Kyung Hwan AN	10/559,738	December 6, 2005	2003-0051165	July 24, 2003	PCT/KR2004/01858	July 23, 2004
5 05-428-C	Device for Implementing a RNC Using LVDS	Kyung Hwan AN	11/534,965	September 25, 2006	2003-0051165	July 24, 2003	PCT/KR2004/01858	July 23, 2004
6 05-429-B	Method of Allocating Links in a IX EVDO System	Kye Choi CHO	10/560,297	December 12, 2005	2003-0051466	July 25, 2003	PCT/KR2004/01880	July 26, 2004
7 05-432-B	Method for Downloading a Single Firmware Image File to Client Systems Having Different CPU Modules	Chan Soo PARK	10/559,225	December 6, 2005	2003-0051153	July 24, 2003	PCT/KR2004/01853	July 23, 2004
8 05-432-C	Method for Downloading a Single Firmware Image File to Client Systems Having Different CPU Modules	Chan Soo PARK	11/534,970	September 25, 2006	2003-0051153	July 24, 2003	PCT/KR2004/01853	July 23, 2004

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MBH&B Reference No.	Title	Inventor(s)	U.S. Application No.	U.S. Filing Date	Korean Application No.	Filing Date (Korean Application)	PCT Application No.	Filing Date PCT National Phase
9 05-433-B	Method for Unifying Operations of Boards by Using Logical Addresses Thereof	Yoon Mi HWANG	10/559,235	December 6, 2005	2003-0051155	July 24, 2003	PCT/KR2004/01855	July 23, 2004
10 05-433-C	Method for Unifying Operations of Boards by Using Logical Addresses Thereof	Yoon Mi HWANG	11/534,960	September 25, 2006	2003-0051155	July 24, 2003	PCT/KR2004/01855	July 23, 2004
11 05-434-B	Method for Establishing an ATM Traffic Channel Path Between a BSC and a BTS in an EV-DO System	Woo Seog KOO	10/560,142	December 9, 2005	2003-0051157	July 24, 2003	PCT/KR2004/001856	July 23, 2004
12 05-438-B	ATM Switch for use in W-CDMA	Cheol Hyun JANG	10/545,578	August 16, 2005	2003-0018557	March 25, 2003	PCT/KR2004/00658	March 25, 2004
13 05-439-B	Remote Unit for Adding Frequency Assignments to a Separation-Type Base Transceiver Station	Jae Ick LEE	10/556,267	November 14, 2005	2003-0034799	May 30, 2003	PCT/KR2004/01276	May 28, 2004
14 05-476-C	Apparatus and Method for Tracking the Position/Object Using a Mobile Communication Network	Choon Geun CHO	10/567,529	February 7, 2006	2003-0066875	September 26, 2003	PCT/KR2004/02466	September 24, 2004
15 05-496-C	Method of Controlling Power in a CDMA-2000 System	Tae Ik SONG	10/568,234	February 14, 2006	2003-0067736	September 30, 2003	PCT/KR2004/02469	September 24, 2004
16 05-497-C	Method of Controlling Power in a W-CDMA Mobile Communication System	Dong Keun KIM	10/569,046	February 22, 2006	2003-0067737	September 30, 2003	PCT/KR2004/02470	September 24, 2004

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MBHB Reference No.	Title	Inventor(s)	U.S. Application No.	U.S. Filing Date	Korean Application No.	Filing Date (Korean Application)	PCT Application No.	Filing Date PCT National Phase
17 05-498-C	Method of Controlling Data Rate for a Forward Data Service in a CDMA 2000-1X System	Jung Han LEE	10/569,041	February 22, 2006	2003-0067738	September 30, 2003	PCT/KR2004/02471	September 24, 2004
18 05-500-B	ATM Switched Router for Transmitting IP Packet Data	Jung Hee PARK	10/585,586	July 11, 2006	2004-0002981	January 15, 2004	PCT/KR2005/00133	January 14, 2005
19 05-507-B	Apparatus and Method for Dualizing an Asynchronous Transfer Mode (ATM) Router in a CDMA2000 System	Tae Hong KIM	10/585,602	July 11, 2006	2004-0002973	January 15, 2004	PCT/KR2005/00134	January 14, 2005
20 05-509-B	Method for Correcting Time Data in a Network Management Application Using a SNMP	Sang Dae PARK	10/586,086	July 13, 2006	2004-0002979	January 15, 2004	PCT/KR2005/00138	January 14, 2005
21 05-511-B	Apparatus and Method for Sensing Faults of Application Programs in a CDMA System	Ki Sung LYU	10/586,289	July 13, 2006	2004-0002980	January 15, 2004	PCT/KR2005/00139	January 14, 2005
22 05-517-B	Automatic Update System and Method for Using a META MIB	Young Jin KIM	10/586,087	July 13, 2006	2004-0002982	January 15, 2004	PCT/KR2005/00140	January 14, 2005

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MBHB Reference No.	Title	Inventor(s)	U.S. Application No.	U.S. Filing Date	Korean Application No.	Filing Date (Korean Application)	PCT Application No.	Filing Date PCT National Phase
23 05-518-B	Structure of a Management Information Base Communicated Between a Network Management System and an Agent of a Network Element	Kwang Seok KANG	10/585,838	July 12, 2006	2004-0002983	January 15, 2004	PCT/KR2005/00141	January 14, 2005
24 05-595-B	Method of Distributing Network Traffic in a Mobile Communication System	Hyun Young SHIN	10/556,924	November 14, 2005	2003-0035283	June 2, 2003	PCT/KR2004/01310	June 2, 2004
25 05-597-B	System and Method for Tracking Position of a Mobile Unit Using Beacons in a Mobile Communications System	June Man KIM	10/560,664	December 13, 2005	2003-0050916	July 24, 2003	PCT/KR2004/01851	July 23, 2004
26 05-615-B	Method for Call Completion Service	Seo Gon CHUN	10/556,274	November 14, 2005	2003-0034806	May 30, 2003	PCT/KR2004/01274	May 28, 2004
27 05-616-B	Method for Automatically Setting a Frequency of a Base Station in a CDMA-2000 System	Ju Hyun BAN; Sang Won SON	10/561,351	December 19, 2005	2003-0051154	July 24, 2003	PCT/KR2004/01854	July 23, 2004

